

REMARKS

Applicant has amended claims 17, 24, and 27-28, and cancelled claims 1-12, during prosecution of this patent application. Applicant is not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner objected to the specification.

The Examiner objected to claims 21-22 and 31-32 under 37 CFR 1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim.

The Examiner objected to claims 17, 24, and 27-28.

The Examiner rejected claims 13, 15, 17-26 and 28-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa (US 2005/0005097 A1) in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

The Examiner rejected claims 16 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

Applicant respectfully traverses the specification objection, claims objections and § 103 rejections with the following arguments.

Specification Objection

The Examiner objected to the specification. The Examiner argues: "The abstract of the disclosure is objected to because "A method for processing a file having an existing filename" (line 1) is not a complete sentence. Correction is required. See MPEP § 608.01(b).

In response, Applicant respectfully contends that the first sentence in the abstract of the present patent application conforms to the requirements for an abstract and is proper. Applicant cites the three sample abstracts in MPEP § 608.01(b), the first sample of which in subsection MPEP § 608.01(b)E(1) has the following first sentence which is of a similar form as the form of the first sentence in the abstract of the present patent application: "A heart valve which has an annular valve body defining an orifice and a plurality of struts forming a pair of cages on opposite sides of the orifice."

Applicant respectfully points out that there are thousands of issued patents having abstracts whose first sentence is of similar form as the form of the first sentence in the abstract of the present patent application, which is proper and acceptable. For example, see the following issued patents with the first sentence of the abstract indicated:

- (1) United States Patent 6,984,271 ("A rare earth magnet to be used in a motor.");
- (2) United States Patent 7,329,033 ("A headlamp assembly for a motor vehicle including a lens and a housing that cooperate to define an inner chamber that is generally isolated from the atmosphere.");
- 3) United States Patent 6,109,872 ("A helicopter rotor cover system to prevent ice formation on the rotors.");
- 4) United States Patent 6,567,890 ("A data storage system having a plurality of disk drives.");

5) United States Patent 6,307,184 ("A processing chamber and methods for employing this processing chamber to thermally treat wafer-like objects.").

Based on the preceding arguments, Applicant respectfully requests that the objection to the specification be withdrawn.

Claim Objections:

Claims 21-22 and 31-32

The Examiner objected to claims 21-22 and 31-32.

The Examiner argues: "Claims 21-22 and 31-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21 and 31 recite a computer readable medium comprising instructions to perform the method of claims 13 and 23, respectively. Claims 22 and 32 recite a system comprising a computer readable medium comprising instructions to perform the method of claims 13 and 23, respectively, and means for executing these instructions. These limitations do not further limit claims 13 and 23."

In response, Applicants notes that the Examiner has cited 37 CFR 1.75(c) which recites the following patent rule: "One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application... Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim."

Applicants next cite 35 U.S.C. § 112, fourth paragraph which recites the patent law that provides the legal foundation for the patent rule in the preceding citation from 37 CFR 1.75(c). In particular, 35 U.S.C. § 112, fourth paragraph recites: "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject

matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”

MPEP § 608.01(n) III explains that the meaning of the preceding citation in 35 U.S.C. § 112, fourth paragraph is governed by the infringement test. In particular, MPEP § 608.01(n) III recites:

“The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (*35 U.S.C. 112, fourth paragraph*) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim... A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. *The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope. ...*” (emphasis added)

Thus, Applicants respectfully contend that the Examiner has applied an incorrect test of whether claims 21-22 and 31-32 are narrower in scope than claims 13 and 23 from which claims 21-22 and 31-32 respectively depend.

Applicants assert that claims 21-22 and 31-32 satisfy the correct legal test for compliance with 35 U.S.C. 112, fourth paragraph, namely the test of whether 21-22 and 31-32 include every limitation of claims 13 and 23, respectively.

In further response, Applicants respectfully assert that claims 21-22 and 31-32 further limit performance of the method of claims 13 and 23, respectively, as follows.

Claim 21 limits performance of the method of claim 13 to being performed by instructions comprised by the computer readable medium. The preceding limitation for performing the method does not exist in claim 13.

Claim 22 limits performance of the method of claim 13 to being performed by instructions comprised by the computer readable medium in accordance with means for executing the instructions. The preceding limitations for performing the method does not exist in claim 13.

Claim 31 limits performance of the method of claim 23 to being performed by instructions comprised by the computer readable medium. The preceding limitations for performing the method does not exist in claim 23.

Claim 32 limits performance of the method of claim 13 to being performed by instructions comprised by the computer readable medium in accordance with means for executing the instructions. The preceding limitations for performing the method does not exist in claim 23.

Based on the preceding arguments, Applicant respectfully requests that the objection to claims 21-22 and 31-32 be withdrawn.

Claims 17, 24, 27, and 28

The Examiner objected to claims 17, 24, 27, and 28. The Examiner argues:

"In claim 17, line 2: "the owner" lacks antecedent basis;

In claim 24, line 1: "the owner" lacks antecedent basis;

In claim 27, line 2: "disposed between between a" should read —disposed between a—;

In claim 28, line 2: "the owner" lacks antecedent basis."

In response, Applicant has amended claims 17, 24, 27, and 28 to correct the
aforementioned errors identified by the Examiner.

Based on the preceding arguments, Applicant respectfully requests that the objection to
claims 17, 24, 27, and 28 be withdrawn.

35 U.S.C. § 103: Claims 13, 15, 17-26 and 28-32

The Examiner rejected claims 13, 15, 17-26 and 28-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa (US 2005/0005097 A1) and in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

Claims 13, 15, and 17-22

Applicant respectfully contends that claim 13 is not unpatentable over Murakawa in view of Bhaskaran, because Murakawa in view of Bhaskaran does not teach or suggest each and every feature of claim 13.

A first example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “receiving, from a certification authority (CA) who issued a digital certificate, a private key associated with the digital certificate and a certificate address from which the digital certificate may be accessed”.

The Examiner argues that Murakawa, Par. 0031, lines 1-3 and 7-10 disclose the preceding feature of claim 13.

In response, Applicant notes that claim 13 requires that a private key, a digital certificate, and a certificate address be received from a certificate authority (CA). Murakawa, Par. 0031, lines 4-10 discloses that the device 100 creates and sends the digital certificate up to the root certificate authority. Thus, the Examiner is arguing that device 100 represents the claimed certification authority from which the digital certificate is received. However, Murakawa, Par.

0031 does not disclose that the private key is received from the certification authority (i.e., from the device 100), as required by the preceding feature of claim 13. To the contrary, Murakawa, Par. 0031, lines 1-3 discloses that the device 100 receives the private key, which is not what is required by the preceding feature of claim 13.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A second example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “generating a digital signature based on the file and the received private key”.

The Examiner argues that Murakawa, Par. 0005, lines 21-22 and 24-28 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Murakawa, Par. 0005, lines 21-22 discloses that generation of the digital certificate is based on a hash value and does not disclose that generation of the digital signature is based on the file and the received private key.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A third example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “encoding the received certificate address to generate an encoded address”.

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0017, lines 10-11 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Bhaskaran, Par. 0017, lines 10-11 discloses: "In FIG. 2, dynamic data 120 are shown as being encoded". However, Bhaskaran, Par. 0017 does not disclose that the dynamic data 120 being encoded is a certificate address, as required by the preceding feature of claim 13. In fact, in Bhaskaran, FIG. 2, examples of the dynamic data 120 to be "settings, parameters, contract nos., order receipts, etc." and are not stated to include a certificate address.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A fourth example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: "merging the existing filename and the encoded address to generate a new filename; and renaming the file with the new filename".

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0014, lines 13-16 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Bhaskaran, Par. 0013, lines 11-13 discloses that the existing filename is "ProductX.exe" and Bhaskaran, Par. 0014, lines 13-16 disclose that the new filename is "ProductX_Y.exe" wherein Y is the dynamic data 120.

However, as explained *supra* in conjunction with the third example, Bhaskaran does not disclose that the dynamic data 120 being encoded is a certificate address.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

Based on the preceding arguments, Applicant respectfully maintains that claim 13 is not unpatentable over Murakawa and in view of Bhaskaran, and that claim 13 is in condition for allowance. Since claims 15 and 17-22 depend from claim 13, Applicant contends that claims 15 and 17-22 are likewise in condition for allowance.

In addition with respect to claim 19, Murakawa and in view of Bhaskaran does not disclose the feature: "wherein the certificate address is an address of a server of the certification authority such that the digital certificate is stored in the server".

The Examiner argues that Murakawa, Par. 0029, lines 14-15 and Par. 0041, lines 7-9 disclose the preceding feature of claim 13.

In response, Applicant has explained in conjunction with claim 13 that the Examiner is arguing that the device 100 represents the claimed certification authority. Since "certification authority" in claim 19 has antecedent basis in "certification authority" in claim 13, it follows that claim 19 requires the recited certification authority to be the same the certification authority as in claim 13, namely the device 100. However, Murakawa, Par. 0029, lines 14-15 and Par. 0041, lines 7-9 does not disclose that the certificate address is an address of a server of the device 100,

as required by the preceding feature of claim 19. Rather, Murakawa, Par. 0041, lines 6-9 refers to the certification authority at the high level (i.e., at the root certificate).

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 19.

Claims 23-26 and 28-32

Applicant respectfully contend that claim 23 is not unpatentable over Murakawa and in view of Bhaskaran, because Murakawa and in view of Bhaskaran does not teach or suggest each and every feature of claim 23.

A first example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “decoding the extracted encoded address to generate a certificate address from which a digital certificate may be accessed”.

The Examiner argues that Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 disclose the preceding feature of claim 23.

In response, Applicant respectively contends that Murakawa, Par. 0031, lines 10-14 disclose decrypting a certificate but does not disclose decoding an address, as required by the preceding feature of claim 13, and Murakawa, Par. 0031, lines 10-14 most certainly does not disclose decoding an encoded address that has been extracted from a filename, as required by the preceding feature of claim 13.

In further response, Applicant notes that Murakawa, Par.0042, lines 6-8 recites “a certificate at the high level (the root certificate in this example) is acquired based on the information in the certificate (S40)”, which is unrelated to the preceding feature of claim 23.

Furthermore, Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 does not disclose generating a certificate address from which a digital certificate may be accessed, as required by the preceding feature of claim 23.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A second example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “said digital certificate comprising a public key associated with the private key”.

The Examiner argues that Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 disclose the preceding feature of claim 23.

In response, Applicant respectfully contends that Murakawa, Par. 0031, lines 10-14 discloses that a public key may be used to decrypt a certificate but does not disclose that the certificate comprises a public key, as required by the preceding feature of claim 23.

In further response, Applicant notes that Murakawa, Par.0042, lines 6-8 recites “a certificate at the high level (the root certificate in this example) is acquired based on the information in the certificate (S40)”, which is unrelated to the preceding feature of claim 23.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A third example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: "accessing the digital certificate from the generated certificate address".

The Examiner argues that Murakawa, Par. 0042, lines 6-8 disclose the preceding feature of claim 23.

In response, Applicant notes that Murakawa, Par.0042, lines 6-8 recites "a certificate at the high level (the root certificate in this example) is acquired based on the information in the certificate (S40)", which does not disclose that the digital certificate is accessed from the generated certificate address which is an address generated from an encoded address in a filename as claimed.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A fourth example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: "extracting the public key from the accessed digital certificate; and verifying the digital signature by executing an authentication algorithm in conjunction with the extracted public key".

The Examiner argues that Murakawa, Par. 0005, lines 25-27 disclose "extracting the public key from the accessed digital certificate" and that Murakawa, Par. 0037, lines 1-2, Par. 0038, lines 1-2, and Par. 0039, lines 1-4 disclose "verifying the digital signature by executing an authentication algorithm in conjunction with the extracted public key".

In response, Applicant respectfully contends that the “public key” in the claimed feature “verifying the digital signature by executing an authentication algorithm in conjunction with the extracted public key” has antecedent basis in the claimed feature “extracting the public key from the accessed digital certificate” and must therefore be the same public key in both features, which is not disclosed by Murakawa.

Murakawa, Par. 0037, lines 1-2, Par. 0038, lines 1-2, and Par. 0039, lines 1-4 disclose that the public key in the feature “” is a public key of the root certificate (see Murakawa, Par. 0037). In contrast, Murakawa, Par. 0005, lines 25-27 and 18-20 disclose that the public key in the feature “extracting the public key from the accessed digital certificate” is a public key of the sending end. However, Murakawa does not disclose that the public key of the root certificate and the public key of the sending end is a same public key, as required by the preceding feature of claim 23.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A fifth example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “extracting the encoded address from the filename”.

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0015, lines 15-17 disclose the preceding feature of claim 13.

In response, Applicant notes that Bhaskaran, Par. 0015, lines 15-17 recites: "The user then reads the new filename to extract this text which may include dynamic data such as settings, parameters, contact numbers, order receipts, etc." Applicant asserts that "settings, parameters, contact numbers, order receipts, etc." does not identify an encoded address, as required by the preceding feature of claim 23.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

Based on the preceding arguments, Applicants respectfully maintain that claim 23 is not unpatentable over Murakawa and in view of Bhaskaran, and that claim 23 is in condition for allowance. Since claims 24-26 and 28-32 depend from claim 23, Applicants contend that claims 24-26 and 28-32 are likewise in condition for allowance.

35 U.S.C. § 103(a): Claim 14

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

Since claim 14 depends from claim 13 which Applicants have argued *supra* to not be unpatentable over Murakawa in view of Bhaskaran under 35 U.S.C. §103(a), Applicants maintain that claim 14 is likewise not unpatentable over Murakawa in view of Bhaskaran, and further in view of Helpfile under 35 U.S.C. §103(a).

35 U.S.C. § 103(a): Claims 16 and 27

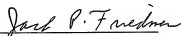
The Examiner rejected claims 16 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

Since claims 16 and 27 depend from claims 13 and 23, respectively, which Applicants have argued *supra* to not be unpatentable over Murakawa in view of Bhaskaran under 35 U.S.C. §103(a), Applicants maintain that claims 16 and 27 are likewise not unpatentable over Murakawa in view of Bhaskaran, and further in view of DiPierro under 35 U.S.C. §103(a).

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

Date: 12/30/2008


Jack P. Friedman
Registration No. 44,688

Customer No. 30449
Schmeiser, Olsen & Watts
22 Century Hill Drive - Suite 302
Latham, New York 12110
Telephone (518) 220-1850
Facsimile (518) 220-1857
E-mail: jfriedman@iplawusa.com